

PTO/SB/26 (09-04)

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**TERMINAL DISCLAIMER TO OBVIATE A DOUBLE PATENTING
REJECTION OVER A "PRIOR" PATENT**

Docket Number (Optional)

29262/35771A

In re Application of: Alan M. Forster et al.

Application No.: 10/647,004-Conf. #1109

Filed: August 22, 2003

For: LABELLED FACTOR XIIIa SUBSTRATES

The owner*, AMERSHAM PLC, of 100 percent interest in the instant application hereby disclaims, except as provided below, the terminal part of the statutory term of any patent granted on the instant application which would extend beyond the expiration date of the full statutory term of **prior patent** No. 6,653,299 as the term of said prior patent is defined in 35 U.S.C. 154 and 173, and as the term of said **prior patent** is presently shortened by any terminal disclaimer. The owner hereby agrees that any patent so granted on the instant application shall be enforceable only for and during such period that it and the **prior patent** are commonly owned. This agreement runs with any patent granted on the instant application and is binding upon the grantee, its successors or assigns.

In making the above disclaimer, the owner does not disclaim the terminal part of the term of any patent granted on the instant application that would extend to the expiration date of the full statutory term as defined in 35 U.S.C. 154 and 173 of the **prior patent**, "as the term of said **prior patent** is presently shortened by any terminal disclaimer," in the event that said **prior patent** later:

- expires for failure to pay a maintenance fee;
- is held unenforceable;
- is found invalid by a court of competent jurisdiction;
- is statutorily disclaimed in whole or terminally disclaimed under 37 CFR 1.321;
- has all claims canceled by a reexamination certificate;
- is reissued; or
- is in any manner terminated prior to the expiration of its full statutory term as presently shortened by any terminal disclaimer.

Check either box 1 or 2 below, if appropriate.

1. ☐ For submissions on behalf of a business/organization (e.g., corporation, partnership, university, government agency, etc.), the undersigned is empowered to act on behalf of the business/organization.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

2. ☒ The undersigned is an attorney or agent of record. Reg. No. 31,879


Signature

December 15, 2004
Date

Jeffrey S. Sharp
Typed or printed name

(312) 474-6300
Telephone Number

- ☒ Terminal disclaimer fee under 37 CFR 1.20(d) is included.

*Statement under 37 CFR 3.73(b) is required if terminal disclaimer is signed by the assignee (owner).
Form PTO/SB/96 may be used for making this certification. See MPEP § 324.

I hereby certify that this correspondence is being deposited with the U.S. Postal Service with sufficient postage as First Class Mail, in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on the date shown below.

Dated: December 15, 2004

Signature:  (Jeffrey S. Sharp)



UNITED STATES PATENT AND TRADEMARK OFFICE

UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND
DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE

SEPTEMBER 02, 2004

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SEP 09 2004

MARSHALL GERSTEIN

UNITED STATES PATENT AND TRADEMARK OFFICE
NOTICE OF RECORDATION OF ASSIGNMENT DOCUMENT

THE ENCLOSED DOCUMENT HAS BEEN RECORDED BY THE ASSIGNMENT DIVISION OF THE U.S. PATENT AND TRADEMARK OFFICE. A COMPLETE MICROFILM COPY IS AVAILABLE AT THE ASSIGNMENT SEARCH ROOM ON THE REEL AND FRAME NUMBER REFERENCED BELOW.

PLEASE REVIEW ALL INFORMATION CONTAINED ON THIS NOTICE. THE INFORMATION CONTAINED ON THIS RECORDATION NOTICE REFLECTS THE DATA PRESENT IN THE PATENT AND TRADEMARK ASSIGNMENT SYSTEM. IF YOU SHOULD FIND ANY ERRORS OR HAVE QUESTIONS CONCERNING THIS NOTICE, YOU MAY CONTACT THE EMPLOYEE WHOSE NAME APPEARS ON THIS NOTICE AT 703-308-9723. PLEASE SEND REQUEST FOR CORRECTION TO: U.S. PATENT AND TRADEMARK OFFICE, ASSIGNMENT DIVISION, BOX ASSIGNMENTS, CG-4, 1213 JEFFERSON DAVIS HWY, SUITE 320, WASHINGTON, D.C. 20231.

RECORDATION DATE: 07/30/2004

REEL/FRAME: 015017/0924
NUMBER OF PAGES: 2

BRIEF: CHANGE OF NAME (SEE DOCUMENT FOR DETAILS).

ASSIGNOR:

NYCOMED AMERSHAM PLC

DOC DATE: 07/12/2001

ASSIGNEE:

AMERSHAM PLC
AMERSHAM PLACE, LITTLE CHALFONT
BUCKINGHAMSHIRE, UNITED KINGDOM

HP7 9NA

SERIAL NUMBER: 09341915

FILING DATE: 10/04/1999

PATENT NUMBER: 6653299

ISSUE DATE: 11/25/2003

TITLE: LABELLED FACTOR XIIIa SUBSTRATES

SERIAL NUMBER: 09341915

FILING DATE: 10/04/1999

PATENT NUMBER: 6653299

ISSUE DATE: 11/25/2003

TITLE: LABELLED FACTOR XIIIa SUBSTRATES



PATENT APPLICATION
Attorney Docket No. 29262/35771

IN THE UNITED STATES PATENT
AND TRADEMARK OFFICE

Applicants:

FORSTER et al.

U.S. Patent No. 6,653,299 B1

Serial No: 09/341,915

Filing Date: Oct. 4, 1999

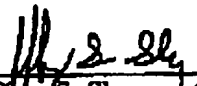
For: Labelled Factor XIIIa Substrates

Group Art Unit: 1621

Examiner: Peter O'Sullivan

) I hereby certify that this correspondence is
) being transmitted via facsimile to Mail
) Stop Assignment Recordation Services,
) Director - U.S. Patent and Trademark
) Office at (703) 306-5995 on this date:

) July 27, 2004

) 
) Jeffrey S. Sharp
) Registration No. 31,879
) Attorney for Applicants

REQUEST FOR RECORDATION OF
ASSIGNEE CHANGE OF NAME

Mail Stop Assignment Recordation Services
Director - U.S. Patent and Trademark Office

Sir:

A Petition To Issue Patent In The Name Of AMERSHAM PLC Under 37 C.F.R. § 3.81(b) was filed in the above-identified application on July 16, 2003 (copy attached hereto as Exhibit A) and was granted on October 6, 2003 (copy attached hereto as Exhibit B). In addition, the Petitions Branch was directed under 37 C.F.R. § 3.81(b) on July 16, 2003 to record the un-recorded change of name pursuant to 3.28 (copy attached hereto as Exhibit C), but U.S. Patent 6,653,299 issued on November 25, 2003 without the requested assignee name change. Applicants have now discovered that the Assignee Change of Name was never recorded in the United States Patent and Trademark Office and has apparently been lost.



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
ASSISTANT SECRETARY AND COMMISSIONER
OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

APRIL 06, 2000

PTAS
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101254623A

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UNITED STATES PATENT AND TRADEMARK OFFICE
NOTICE OF RECORDATION OF ASSIGNMENT DOCUMENT

MARSHALL O'TOOLE

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RECORDATION DATE: 12/27/1999

REEL/FRAME: 010507/0232
NUMBER OF PAGES: 5

BRIEF: ASSIGNMENT OF ASSIGNOR'S INTEREST (SEE DOCUMENT FOR DETAILS).

ASSIGNOR:

FORSTER, ALAN MICHAEL

DOC DATE: 08/04/1999

ASSIGNOR:

KNOX, PETER

DOC DATE: 07/30/1999

ASSIGNOR:

MENDIZABAL, MARIVI

DOC DATE: 08/16/1999

ASSIGNOR:

RICHARDSON, TIMOTHY CHARLES

DOC DATE: 09/08/1999

ASSIGNOR:

STOREY, ANTHONY EAMON

DOC DATE: 08/04/1999

ASSIGNOR:

WILSON, IAN ANDREW

DOC DATE: 08/04/1999

ASSIGNOR:

CHAMPION, SUSAN

DOC DATE: 08/17/1999

010507/0232 PAGE 2

ASSIGNOR:
GIBSON, ALEX

DOC DATE: 08/04/1999

ASSIGNOR:
GUILBERT, BENEDICTE

DOC DATE: 08/04/1999

ASSIGNEE:
NYCOMED AMERSHAM PLC
AMERSHAM PLACE
LITTLE CHALFONT
BUCKINGHAMSHIRE, HP7 9NA
GREAT
BRITAIN

SERIAL NUMBER: 09341915
PATENT NUMBER:

FILING DATE: 10/04/1999
ISSUE DATE:

MARCUS KIRK, EXAMINER
ASSIGNMENT DIVISION
OFFICE OF PUBLIC RECORDS

02-01-2000



2

<p>1. Name of party or parties conveying an interest:</p> <p>ALAN MICHAEL FORSTER PETER KNOX MARIVI MENDIZABAL TIMOTHY CHARLES RICHARDSON ANTHONY EAMON STOREY IAN ANDREW WILSON SUSAN CHAMPION ALEX GIBSON BENEDICTE GUILBERT</p>	<p>2. Name and address of party or parties receiving an interest:</p> <p>Name: NYCOMED AMERSHAM PLC a British corporation Address: Amersham Place, Little Chalfont, Buckinghamshire, HP7 9NA</p>
<p>3. Description of the interest conveyed:</p> <p><input checked="" type="checkbox"/> Assignment <input type="checkbox"/> Merger <input type="checkbox"/> Change of Name <input type="checkbox"/> Security Agreement</p> <p>Execution Date: August 4, 1999, July 30, 1999, August 16, 1999, September 8, 1999, August 17, 1999</p>	<p>Other:</p>
<p>4. Application number(s) or patent number(s). Additional sheet attached? YES <input type="checkbox"/> NO <input checked="" type="checkbox"/></p> <p>A. Patent Application no.(s): 09/341,915</p>	<p>If the document is being filed together with a new application, the execution date of the application is:</p> <p>B. Patent no.(s):</p>
<p>5. Name and address of party to whom correspondence concerning this cover sheet should be mailed:</p> <p>Name: Jeffrey S. Sharp Reg. No. 31,879 MARSHALL, O'TOOLE, GERSTEIN, MURRAY & BORUN Street Address: 6300 Sears Tower 233 S. Wacker Drive City: Chicago State: Illinois Zip: 60606-6402</p>	<p>6. Number of applications and/or patents identified on this cover sheet: 1</p> <p>7. Amount of fee enclosed or authorized to be charged: \$40.00</p> <p>8. Any additional required fee may be charged, or any overpayment credited to our deposit account: 13-2855</p>

9. To the best of my knowledge and belief, the information contained on this cover sheet is true and correct and any copy submitted is a true copy of the original document.

Date: December 17, 1999

Jeffrey S. Sharp
Jeffrey S. Sharp
Reg. No. 31,879

ASSIGNMENT

Serial No: 09/341,915
 Filed: July 20, 1999
 Title: Labelled Factor XIIIa Substrates

For _____, and other good and valuable consideration, the receipt and sufficiency whereof are hereby acknowledged, the undersigned hereby assign(s) to NYCOMED AMERSHAM PLC, a British Corporation, Amersham Place, Little Chalfont, Buckinghamshire, HP7 9NA (hereinafter "Assignee"), its successors and assigns, the entire right, title and interest in the invention or improvements of the undersigned disclosed in an application for Letters Patent of the United States, executed by the undersigned on even date herewith, and in said application and any and all other applications, both United States and foreign, which the undersigned may file, either solely or jointly with others, on said invention or improvements, and in any and all Letters Patent of the United States and foreign countries, which may be obtained on any of said applications, and in any reissue or extension thereof.

The undersigned hereby authorize(s) and request(s) the Commissioner of Patents and Trademarks to issue said Letters Patent to said assignee.

The undersigned hereby authorize(s) and request(s) the attorneys of record in said application to insert in this assignment the execution date and/or filing date and serial number of said application when officially known.

The undersigned warrant(s) themselves (himself/herself) to be the owners (owner) of the interest herein assigned and to have the right to make this assignment and further warrant(s) that there are no outstanding prior assignments, licenses, or other rights in the interest herein assigned.

For said consideration the undersigned hereby agree(s), upon the request and at the expense of said assignee, its successors and assigns, to execute any and all divisional, continuation, continuation-in-part and substitute applications for said invention or improvements, and any necessary oath or affidavit relating thereto, and any application for the reissue or extension of any Letters Patent that may be granted upon said application, and any and all applications and other documents for Letters Patent in foreign countries on said invention or improvements, that said assignee, its successors or assigns, may deem necessary or expedient, and for the aforesaid consideration the undersigned further agree(s) upon the request of said assignee, its successors or assigns, in the event of any application or Letters Patent assigned herein becoming involved in Interference, to cooperate to the best of the ability of the undersigned with said assignee, its successors or assigns, in the matters of preparing and executing the preliminary statement and giving and producing evidence in support thereof, the undersigned hereby agreeing to perform, upon request, any and all affirmative acts to obtain said Letters Patent, both United States and foreign, and vest all rights therein hereby conveyed in said assignee, its successors and assigns, whereby said Letters Patent will be held and enjoyed by said assignee, its successors and assigns, to the full end of the term for which said Letters Patent may be granted as fully and entirely as the same would have been held and enjoyed by the undersigned if this assignment and sale had not been made.

WITNESS my (our) hand(s) this 4th day of August, Nineteen Hundred and 99.

Witnesses:

1) John R. Hock
 Name:

2) James Navio
 Name:

Alan M. Forster
 Name ALAN MICHAEL FORSTER

WITNESS my (our) hand(s) this 30th day of JULY, Nineteen Hundred and 99.

Witnesses:

1) A.T. Collins

Name: A.T. COLLINS

Peter Knox

Name: PETER KNOX

2) Villette Fletcher

Name: VILLETTE FLETCHER

WITNESS my (our) hand(s) this 16th day of August, Nineteen Hundred and 99.

Witnesses:

1) Kirsty Danks

Name: KIRSTY DANKS

Marivi Mendizabal

Name: MARIVI MENDIZABAL

2) Rhian Stewart

Name: RHIAN STEWART

WITNESS my (our) hand(s) this 8th day of September, Nineteen Hundred and 99.

Witnesses:

1) Jane Milsom

Name: JANE MILSOM

T.C. Richardson

Name: TIMOTHY CHARLES RICHARDSON

2) Jayne Saunders

Name: JAYNE SAUNDERS

WITNESS my (our) hand(s) this 4th day of AUGUST, Nineteen Hundred and 99.

Witnesses:

1) Judith Hick
Name: JUDITH HICK

A E Storey
Name ANTHONY EAMON STOREY

2) Sally Bannan
Name: SALLY BANNAN

WITNESS my (our) hand(s) this 4th day of August, Nineteen Hundred and 99.

Witnesses:

1) Sally Bannan
Name: SALLY BANNAN

Ian Andrew Wilson
Name IAN ANDREW WILSON

2) L. Pickering
Name: L. PICKERING

WITNESS my (our) hand(s) this 17th day of August, Nineteen Hundred and 99.

Witnesses:

1) Kathryn Bell
Name: KATHRYN BELL

Susan Champion
Name SUSAN CHAMPION

2) Lucinda Dollimore
Name: LUCINDA DOLLIMORE

WITNESS my (our) hand(s) this 4th day of August, Nineteen Hundred and 99.

Witnesses:

1) [Signature]
Name:

[Signature]
Name ALEX GIBSON

2) [Signature]
Name:

WITNESS my (our) hand(s) this 6th day of August, Nineteen Hundred and 99.

Witnesses:

1) [Signature]
Name:

[Signature]
Name BENEDICTE GUILBERT

2) [Signature]
Name:

WITNESS my (our) hand(s) this _____ day of _____, Nineteen Hundred and _____.

Witnesses:

1) _____
Name:

Name

2) _____
Name: